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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,920

12/21/2005

Yoshitsugu Morita

71,051-002

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27305

7590

06/23/2008

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EXAMINER

KASSA, TIGABU

ART UNIT

PAPER NUMBER

4161

MAIL DATE

DELIVERY MODE

06/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,920	Applicant(s) MORITA ET AL.	
	Examiner TIGABU KASSA	Art Unit 4161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/30/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of the Claims

This application is a 371 of PCT/JP03/10888 filed on 08/27/2003, which is filled at national stage 12/21/2005. Claims 1-13 are currently pending and are the subject of this Office Action. This is the first Office Action on the merits of the claims.

Priority

The earliest effective filing date afforded for the instantly claimed invention, has been determined to be 08/27/2003, the filing date of the PCT/JP03/10888.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 06/30/2005 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness

4. Claims 1-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US patent 5,928,660, Issued on July 27, 1999) and Tanaka et al. (WO 02/094213, Published on 28/11/2002) and as evidenced by (Frederick C. Mish et al. Webster's ninth new collegiate dictionary, 1097, Meriam-Webster Inc., 9th edition, 1990), and (http://www.dowcorning.com/content/sitech/sitechbasics/siloxane_polymerization.asp).

5. Instant claim 1 recites aqueous suspensions of cross-linked silicone particles comprising cross-linked silicone particles with an average particle size of from 0.1 to 500 μm , surfactant (N-acyl-, N-hydrocarbon taurines), and water.

6. Kobayashi et al. (US patent 5,928,660) discloses a raw material for cosmetic use comprising an aqueous suspension of a powdered silicon rubber (column 2, lines 14-16). The mean particle size of this powdered silicone rubber is in the range of 0.1 to 50

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microns, and is preferably in the range of 0.5 to 50 (column 2, lines 17-20) and with particle size of 0.1 to 500 microns (see Abstract). Silicone rubber is “a rubber made from silicone elastomers and noted for its retention of flexibility, resilience, and tensile strength over a wide temperature range” as defined by (Frederick C. Mish et al. Webster’s ninth new collegiate dictionary, 1097, Meriam-Webster Inc., 9th edition, 1990). In basic silicone chemistry it is also known that silicone elastomers are cross-linked fluids whose three-dimensional structure is much more intricate than a gel (http://www.dowcorning.com/content/sitech/sitechbasics/siloxane_polymerization.asp). Hence, by inherency the powdered silicon rubber particles are cross-linked particles. Kobayashi et al. (US patent 5,928,660) also discloses that in order to achieve a stable dispersion of these silicone rubber compositions as fine particles in water, it is desirable to use one or more nonionic, cationic, and/or anionic surfactants and also specifically mentions that “since these surfactants are mixed with the cosmetic “as is”, it is necessary to use surfactants that can be utilized as cosmetic raw materials.”

Although, Kobayashi et al. (US patent 5,928,660) didn’t mention specific types of chemicals such as N-hydrocarbon taurines as surfactant, it discloses as discussed above the general types of surfactants, which are known to be used in the cosmetics art.

However, Tanaka et al. (WO 02/094213) discloses the use of N-acyl-, N-hydrocarbon taurines as surface stabilizing agents (surfactants) to stabilize the dispersion of a raw material for cosmetic use comprising polyorganosiloxane and water (see Abstract and page 9, lines 1-9).

7. Hence, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to substitute one surfactant type by the other for the same intended use.

8. Instant claim 2 recites the aqueous suspensions in further limitations contain non-cross-linkable oil in the cross-linked silicone particles.

9. Kobayashi et al. (US patent 5,928,660) teaches that the aqueous suspension of a powdered silicone rubber contains a non-cross-linked oil (column 3, lines 24-28).

10. Instant claim 3 recites % weight ranges for the three components of the aqueous suspensions as recited in instant claim 1.

11. Kobayashi et al. (US patent 5,928,660) teaches that the content of the powdered silicone rubber in the composition is in the range of 10 to 80 wt %, (column 5, lines 42-45), 50 parts by weight of water (column 7, lines 59-61), and surfactant in the range of 0.1 to 20 parts by weight (preferably 0.5 to 10 parts by weight) per 100 parts by weight of silicone rubber composition.

12. Instant claim 4 recites an aqueous emulsion of oil containing cross-linked silicone particles in further limitation containing oil.

13. Kobayashi et al. (US patent 5,928,660) also teaches the three components of the aqueous suspension as discussed above while addressing instant claim 1.

Additionally, Kobayashi et al. (US patent 5,928,660) also discloses that the suspension also contains non-cross-linked oil specifically being added in the silicon rubber powder particles as discussed above. Kobayashi et al. (US patent 5,928,660) also specifically gives examples were an aqueous emulsion of silicone rubber composition after the

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addition of the oil (column 1, lines 60-61 and column 8, lines 61-65), which addresses the limitation of the aqueous emulsions of cross-linked silicone particles as recited in instant claim 4.

14. Instant claim 5 recites % weight ranges for the three components of the aqueous suspensions as recited in instant claim 4.

15. Kobayashi et al. (US patent 5,928,660) also discloses that the content of the non-cross-linked oil in the powdered silicone rubber is 80 wt % or less and a content of 50 wt% or less is especially desirable (column 4, lines 56-63), 50 parts by weight of water (column 7, lines 59-61), and surfactant in the range of 0.1 to 20 parts by weight (preferably 0.5 to 10 parts by weight) per 100 parts by weight of silicone rubber composition.

16. Instant claims 6 and 7 recite cosmetic raw materials comprising the aqueous suspensions and in further limitation the aqueous emulsions.

17. Kobayashi et al. (US patent 5,928,660) discloses a cosmetic raw material which allows the uniform dispersion of a powdered silicone rubber in a cosmetic containing the above discussed components including the aqueous emulsion.

19. As discussed above Tanaka et al. (WO 02/094213) teaches the use of the various types of N-hydrocarbon taurines and their salts as surfactants (page 3, lines 13-33).

20. Instant claim 8 and 11 recite in the aqueous suspensions N-acyl-, N-hydrocarbon taurines is selected from the group of sodium N-lauroyl methyl taurine, sodium N-myristoyl methyl taurine.....).

21. Tanaka et al. (WO 02/094213) teaches that in the polyorganosiloxane microemulsion composition the N-hydrocarbon taurines can be selected from the group N-lauroyl methyl taurine sodium salt, N-myristoyl methyl taurine sodium salt etc (page 3, lines 25 and 27), which reads on claims 8 and 11.

22. Hence, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to substitute one surfactant type by the other for the same intended use for preparation of cosmetic products.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9-10 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 9-10 recite the limitation N-acyl-, N-hydrocarbon taurines with the specified structure which carries all the limitations of claim 1 and claims 12-13 recite the limitation N-acyl-, N-hydrocarbon taurines with the specified structure which carries all the limitations of claim 4. There is insufficient antecedent basis for the given structure or limitation in the claims that they depend on.

4. Claims 9-10 and 12-13 are vague and indefinite and there is no clear positive prior antecedent basis for the specific structure of N-acyl-, N-hydrocarbon taurines in

claims 1 and 4 upon which claims 9-10 and 12-13 respectively depend. It will be remedial to amend the claims to indicate the dependency.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIGABU KASSA whose telephone number is (571)270-5867. The examiner can normally be reached on 9 am-5 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Patrick J. Nolan/

Supervisory Patent Examiner, Art Unit 4161